



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,681	05/22/2002	Kalevi Ratschunas	4925-219PUS	2735

7590 11/15/2006

Michael C Stuart
Cohen Pontani Lieberman & Pavane
551 Fifth Avenue Suite 1210
New York, NY 10176

EXAMINER

HASHEM, LISA

ART UNIT PAPER NUMBER

2614

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,681

Applicant(s)

RATSCHUNAS ET AL.

Examiner

Lisa Hashem

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-12, 14-17, 20-23, 35 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-12, 14-17, 20-23, 35, and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The Office Action filed on 6-19-06 is vacated because Applicant's arguments, see After Final Amendment, filed 9-12-06, with respect to claims 1-5, 8-12, 14-17, 20-23, 35, and 37-39 have been fully considered and are persuasive. Therefore, the Final Rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.
2. The response to the After Final Amendment filed 9-12-06 is a Non-Final Office Action and is set forth below. Please disregard the Office Action mailed on 9-12-06.

Claim Objections

3. Claim 2 is objected to because of the following informalities: Claim 2 recites the limitation "said setting step". There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.
4. Claim 12 is objected to because of the following informalities: Claim 12 recites the limitation "said message". There is insufficient antecedent basis for this limitation in the claim. The preamble discloses delivering messages and not delivering a single message. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5, 8, 9, and 10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Pat. No. 4,972,461 by Brown et al, hereinafter Brown.

Regarding claim 1, Brown discloses a method for delivering messages in a network (Fig. 1) comprising at least one terminal device (Fig. 1: 163), comprising:

generating a message;

setting a condition for receiving said message (col. 8, lines 5-31);

deciding whether said message is to be received by a terminal device based on said condition;

transmitting said message to said terminal device based on deciding whether the message is to be received (col. 12, line 38 – col. 14, line 44);

deciding whether the originator of said message is allowed to receive a delivery report (col. 9, line 20 – col. 10, line 18; col. 13, lines 28-44; e.g. valid billing code is entered to receive delivery report or notification call is requested for status of delivery);

and transmitting said delivery report to the originator of said message only when said originator of said message is allowed to receive the delivery report (col. 9, line 61 – col. 10, line 18; col. 13, lines 28-44);

Art Unit: 2614

wherein a list of originators of messages which are allowed to receive delivery reports is stored in a database (Fig. 1, 123; e.g. service unit (SU)) (e.g. inherently the system must have a record of originators that are allowed to receive delivery reports since the system services multiple subscribers that can call into the system and send a message and receive delivery status on that message, the system must distinguish between the different originators and delivery reports) (col. 6, lines 66-68; col. 8, lines 53-59; col. 9, line 61 – col. 10, line 18; col. 13, lines 28-44).

Regarding claim 2, the method according to claim 1, wherein Brown further discloses said setting step is performed by a terminal device (col. 8, lines 5-31).

Regarding claim 3, the method according to claim 1, wherein Brown further discloses said condition is a location of said terminal device (col. 13, lines 48-55; col. 14, lines 45-53).

Regarding claim 4, the method according to claim 1, wherein Brown further discloses including information regarding said condition in an optional field of said message (col. 11, lines 18-45; col. 12, lines 20-29).

Regarding claim 5, the method according to claim 1, wherein Brown further discloses determining whether said terminal device is inactive or busy when said condition is not met (col. 12, lines 38-51).

Regarding claim 8, the method according to claim 1, wherein Brown further discloses defining a group of users (e.g. originators with valid billing codes) which are allowed to receive delivery reports, wherein whether the originator of said received message is a member of said group of users is determined during said deciding step (col. 8, lines 53-59; col. 9, line 61 – col. 10, line 18; col. 11, lines 3-14).

Art Unit: 2614

Regarding claim 9, the method according to claim 8, wherein Brown further discloses the step of adding a group identifier identifying said group of users to said message (col. 11, lines 18-45).

Regarding claim 10, the method of claim 1, wherein Brown further discloses said message is a multimedia message (col. 15, lines 62-63).

7. Claims 12, 14, 20, 21, 23, 35, 37, and 39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Pat. No. 6,289,223 by Mukherjee et al, hereinafter Mukherjee.

Regarding claim 12, Mukherjee discloses a network system for delivering messages in a network (Fig. 1), comprising:

a terminal device (e.g. a service center; Fig. 1, 18; Fig. 4, 170) comprising a judging means configured to determine whether a delivery report is to be transmitted in response to said message (col. 4, lines 17-37; col. 6, lines 13-30; e.g. delivering a report to an authorized originator when said message is sent to a recipient),

a transmitting means configured to transmit said delivery report when said judging means determines that said delivery report is to be transmitted (col. 6, lines 21-30), and

database (e.g. multipoint usergroup database; Fig. 2, 26) having a stored list of originators of message is stored (e.g. specified originator list) (Fig. 2),

which are allowed to receive delivery reports, and which is accessed by said judging means (col. 4, lines 7-58; col. 5, lines 6-21; col. 5, line 66 – col. 6, line 30); and

a message delivering device comprising a deciding means configured to decide whether a message is to be received by said terminal device based on a condition (e.g. if the originator is

Art Unit: 2614

allowed to send a SMS message to a receiving subscriber or receiving group of subscribers) for receiving said message (col. 4, lines 7-37; col. 6, lines 21-30), and a transmitting means configured to transmit said message to said terminal device based on said deciding means determining whether the message is to be received (col. 6, lines 21-30).

Regarding claim 14, the system of claim 12, wherein Mukherjee further discloses a setting means configured to set a condition for receiving a message by said terminal device (col. 3, line 34 – col. 4, line 58).

Regarding claim 20, the system of claim 12, wherein Mukherjee further discloses a group of users (e.g. specified originator list) permitted to receive delivery reports, and said judging means configured to detect whether an originator of said received message is a member of said group of users is determined (col. 3, line 46 – col. 4, line 37; col. 6, lines 13-30).

Regarding claim 21, the system of claim 20, wherein Mukherjee further discloses a group identifier identifying said group of users is added to said message (Fig. 2; col. 3, line 46 – col. 4, line 37; col. 6, lines 13-30).

Regarding claim 23, the system of claim 12, wherein Mukherjee further discloses said network is a mobile network (Fig. 1) and said terminal device is a mobile terminal device (Fig. 1, 12) (col. 3, lines 3-33).

Regarding claim 35, Mukherjee discloses a terminal device (e.g. a service center; Fig. 1, 18; Fig. 4, 170) for receiving a message for which a condition (col. 3, lines 15-21; col. 4, lines 7-44) for receiving said message is set for use in network (Fig. 1; Fig. 4), comprising: a receiving means configured to receive said message (col. 4, lines 59-66; col. 5, lines 37-43);

Art Unit: 2614

a judging means configured to determine whether a delivery report is to be transmitted in response to said message (e.g. delivering a report to an authorized originator when said message is sent to a recipient); and

a transmitting means configured to transmit said delivery report when said judging means determine that said delivery report is to be transmitted (col. 6, lines 21-30);

a database (e.g. multipoint usergroup database; Fig. 2, 26) having a stored list of originators of messages (Fig. 2, 26), which are allowed to receive delivery reports, and which is accessed by said judging means (col. 4, lines 7-58; col. 5, lines 6-21; col. 5, line 66 – col. 6, line 30).

Regarding claim 37, the terminal device of claim 35, wherein Mukherjee further discloses said condition is a location of said terminal device (col. 3, lines 15-21; col. 4, lines 7-44).

Regarding claim 39, the terminal device of claim 35, wherein Mukherjee further discloses said network is a mobile network (Fig. 1; Fig. 4) and said terminal device is a mobile terminal device (e.g. device connected to a mobile network) (Fig. 1, 18; Fig. 4, 170) (col. 3, lines 3-33; col. 5, lines 37-65; col. 6, lines 21-30).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, as applied to claim 1, in further view of Mukherjee.

Regarding claim 11, the method according to claim 1, wherein Brown does not disclose said network is a mobile network and said terminal device is a mobile terminal device.

Mukherjee discloses a method for delivering messages in a network (Fig. 1) comprising at least one terminal device (Fig. 1: 12), comprising (see Abstract; col. 3, line 3 – col. 4, line 37): generating a message (col. 2, lines 5-21; col. 4, lines 7-9 and lines 62-66); setting a condition for receiving said message (e.g. if the originator is allowed to send a SMS message to a receiving subscriber or receiving group of subscribers) (col. 4, lines 7-37); deciding whether said message is to be received by a terminal device based on said condition (col. 6, lines 21-30); transmitting said message to said terminal device based on deciding whether the message is to be received (col. 6, lines 21-30); deciding whether the originator of said message is allowed to send said message (col. 4, lines 17-37; col. 6, lines 13-30); and transmitting a delivery report to the originator of said message only when said originator of said message is allowed to receive the delivery report (e.g. authorized to send a SMS message); wherein a list of originators of messages (e.g. specified originator list) (Fig. 2) which are allowed to receive delivery reports is stored in a database (e.g. multipoint usergroup database; Fig. 2, 26) (col. 4, lines 7-58; col. 5, lines 6-21; col. 5, line 66 – col. 6, line 30).

Wherein Mukherjee further discloses said network is a mobile network (Fig. 1) and said terminal device is a mobile terminal device (Fig. 1, 12) (col. 3, lines 3-33).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Brown to include said network is a mobile network and said

Art Unit: 2614

terminal device is a mobile terminal device as taught by Mukherjee. One of ordinary skill in the art would have been lead to make such a modification to include sending a message from a standard telephone system to a recipient with a mobile terminal device in a mobile network, wherein the caller can enter a message recipient's mobile terminal number as the destination of the message.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee, as applied to claim 12, in further view of U.S. Pat. No. 6,119,014 by Alperovich et al, hereinafter Alperovich.

Regarding claim 15, the system of claim 12, wherein Mukherjee does not disclose said condition is a location of said terminal device.

Alperovich discloses a system for delivering messages in a network (Figs. 1-4) comprising at least one terminal device (Fig. 4: 400, 480), comprising:
generating a message (e.g. SMS message; Fig. 4, 420) (col. 5, lines 27-30);
setting a condition (e.g. priority indication, location information) for receiving said message (col. 4, lines 7-12; col. 5, lines 27-35);
deciding whether said message is to be received by a terminal device based on said condition (e.g. if terminal device is in location area corresponding to the location information then send the message);
transmitting said message to said terminal device (Fig. 4, 400) based on deciding whether the message is to be received (e.g. whether the terminal device is in the location area) (col. 5, line 50 – col. 6, line 3);

Art Unit: 2614

the originator of said message is allowed to receive a delivery report (e.g. deciding whether the message was delivered); and
transmitting said delivery report to the originator of said message (col. 2, line 20 – col. 3, line 11).

Wherein Alperovich further discloses said condition is a location of said terminal device (col. 5, line 27 – col. 6, line 3).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Mukherjee to include said condition is a location of said terminal device as taught by Alperovich. One of ordinary skill in the art would have been lead to make such a modification to include a condition, such as location, that can be set for delivering a message to a terminal in order to reduce load on the network since no messages are transmitted which are not required and the delivering of the message is dependent on whether the terminal is in a particular area to send, for example, advertisements or information regarding a specific area.

11. Claims 16, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee, as applied to claim 12, in further view of U.S. Pat. No. 5,966,663 by Gleason.

Regarding claim 16, the system of claim 12, wherein Mukherjee said message comprises an optional field in which information regarding said condition is included.

Gleason discloses a system for delivering messages in a network comprising at least one terminal device (e.g. cellular telephone; Fig. 1, 16) (see Abstract; col. 6, lines 13-28),
comprising:
generating a message;

Art Unit: 2614

setting a condition for receiving said message (col. 10, lines 46-55; col. 12, lines 2-7; col. 24, line 66 – col. 25, line 2);

deciding whether said message is to be received by a terminal device (Fig. 1, 16) based on said condition (col. 10, lines 58-65);

transmitting said message to said terminal device based on deciding whether the message is to be received (col. 8, line 49 – col. 9, line 6; col. 10, lines 58-65; col. 12, lines 46-57);

deciding whether the originator of said message is allowed to receive a delivery report (col. 25, lines 16-26); and

transmitting said delivery report to the originator of said message only when said originator of said message is allowed to receive the delivery report (col. 12, lines 57-61; col. 20, lines 44-53; col. 25, lines 16-26).

Wherein Gleason further discloses said message comprises an optional field in which information regarding said condition is included (col. 20, lines 55-67; col. 24, line 56 - col. 29, line 31).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Mukherjee to include information regarding said condition in an optional field of said message as taught by Gleason. One of ordinary skill in the art would have been lead to make such a modification in order for the optional field that includes the condition to be easily detected within the message.

Regarding claim 17, the system according to claim 12, wherein Mukherjee does not disclose wherein said message delivering device further comprises a determining means

configured to determine whether said terminal device is not reachable when said deciding means decides that said condition is unmet.

Gleason discloses a system for delivering messages in a network comprising at least one terminal device (e.g. cellular telephone; Fig. 1, 16) (see Abstract; col. 6, lines 13-28),

comprising:

generating a message;

setting a condition for receiving said message (col. 10, lines 46-55; col. 12, lines 2-7; col. 24, line 66 – col. 25, line 2);

deciding whether said message is to be received by a terminal device (Fig. 1, 16) based on said condition (col. 10, lines 58-65);

transmitting said message to said terminal device based on deciding whether the message is to be received (col. 8, line 49 – col. 9, line 6; col. 10, lines 58-65; col. 12, lines 46-57);

deciding whether the originator of said message is allowed to receive a delivery report (col. 25, lines 16-26); and

transmitting said delivery report to the originator of said message only when said originator of said message is allowed to receive the delivery report (col. 12, lines 57-61; col. 20, lines 44-53; col. 25, lines 16-26).

Wherein Gleason further comprises a determining means configured to determine whether said terminal device is not reachable when said deciding means decides that said condition is unmet (col. 6, lines 16-28; col. 12, lines 54-57; col. 24, line 66 – col. 25, line 2).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Mukherjee to include determining whether said terminal

Art Unit: 2614

device is inactive or busy when said condition is not met as taught by Gleason. One of ordinary skill in the art would have been lead to make such a modification in order to handle delivering messages in the same way as if the terminal is not available at the moment, wherein the method can omit a special procedure for handling messages which do not meet the condition and it can be decided whether delivering of the message should be retried later or whether the message should not be delivered at all.

Regarding claim 22, the system of claim 12, wherein Mukherjee does not disclose said message is a multimedia message.

Gleason discloses a system for delivering messages in a network comprising at least one terminal device (e.g. cellular telephone; Fig. 1, 16) (see Abstract; col. 6, lines 13-28),

comprising:

generating a message;

setting a condition for receiving said message (col. 10, lines 46-55; col. 12, lines 2-7; col. 24, line 66 – col. 25, line 2);

deciding whether said message is to be received by a terminal device (Fig. 1, 16) based on said condition (col. 10, lines 58-65);

transmitting said message to said terminal device based on deciding whether the message is to be received (col. 8, line 49 – col. 9, line 6; col. 10, lines 58-65; col. 12, lines 46-57);

deciding whether the originator of said message is allowed to receive a delivery report (col. 25, lines 16-26); and

Art Unit: 2614

transmitting said delivery report to the originator of said message only when said originator of said message is allowed to receive the delivery report (col. 12, lines 57-61; col. 20, lines 44-53; col. 25, lines 16-26).

Wherein Gleason said message is a multimedia message (e.g. a MM can contain all kind of messages, like sounds, speech, etc.) (col. 10, lines 28-30; col. 12, lines 4-7; col. 37, lines 54-57).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the system of Mukherjee to include said message is a multimedia message as taught by Gleason. One of ordinary skill in the art would have been lead to make such a modification in order to deliver a variety of messages including pictures, video clips, sounds, speech, etc.

12. Claim 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee, as applied to claim 35, in further view of Gleason.

Regarding claim 38, the terminal device of claim 35, wherein Mukherjee does not disclose said message is a multimedia message.

Gleason discloses a terminal device (Fig. 1, 10) for receiving a message for which a condition for receiving said message is set for use (col. 10, lines 46-55; col. 12, lines 2-7; col. 24, line 66 – col. 25, line 2) in network (Fig. 1), comprising:

a receiving means configured to receive said message (col. 10, line 46 – col. 11, line 10);

a judging means configured to determine whether a delivery report is to be transmitted in response to receiving said message;

and

Art Unit: 2614

a transmitting means configured to transmit said delivery report when said judging means determines that said delivery report is to be transmitted (col. 12, lines 46-57; col. 20, lines 44-53; col. 25, lines 16-26).

Wherein Gleason said message is a multimedia message (e.g. a MM can contain all kind of messages, like sounds, speech, etc.) (col. 10, lines 28-30; col. 12, lines 4-7; col. 37, lines 54-57).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the terminal device of Mukherjee to include said message is a multimedia message as taught by Gleason. One of ordinary skill in the art would have been lead to make such a modification in order to deliver a variety of messages including pictures, video clips, sounds, speech, etc.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

14. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

Art Unit: 2614


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh

November 3, 2006


FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600